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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/304,973	05/04/1999	EDWARD BALASSANIAN		1456

25096 7590 07/14/2004

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EXAMINER

CALDWELL, ANDREW T

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 07/14/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

***Request for Information***

The Applicant(s) and the assignee, if any, are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application:

a. Identify the allegedly infringing method that was the basis for the Petition to Make Special by providing a copy of the rigid comparison of the alleged infringing device, product, or method to the claims of the application that was used as the basis of the petition to make special. The identity of the allegedly infringing method and the rigid comparison are necessary because they indicate the technical subject matter that falls within the scope of the claims.

Furthermore, even though information may not be *prior* art, information that is after the Applicants' filing date often leads to relevant prior art. The identity of the allegedly infringing method and the rigid comparison are therefore reasonably necessary because they are likely to lead to relevant prior art.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in the Applicants' disclosure.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the Applicants' first complete communication in responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The Applicants are reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the Applicants do not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

### ***Response to Arguments***

As to the Applicant's arguments filed in the Response to the Request for Information, filed September 25, 2003, concerning the requirement for the Applicants to identify the accused infringing method, the Applicant's arguments have been fully considered but they are not persuasive.

The Applicants argue that the identity of the allegedly infringing method is not reasonably necessary to properly examine the application because 37 CFR 1.105(a)(1)(vii) only allows the Examiner to request information known *at the time the*

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*application was filed.* This argument is not deemed persuasive. First, the portion of the rule relied upon by the Applicants are related to public use or sale. They are not relevant to this issue. Second, 37 CFR 1.105(a)(1)(vii) is merely one possible basis for the requirement. The Examiner fails to see why the requirement for the rigid comparison does not also fall under 37 CFR 1.105(a)(1)(iii) – Related Information. Third, 37 CFR 1.105(a)(1)(i)-(vii) are merely *examples* of the type of information that can be required by the Examiner. By using the phrase “for example” in 37 CFR 1.105(a)(1), the plain language of the rule clearly indicates that the examples are not the only types of information that can be requested.

The Applicants also argue that the fact that the rules don't require them to identify the allegedly infringing method in their petition to make special prohibits the Examiner for requiring the information later in a request for information. However, the mere fact that the information is not needed in order to grant the petition to examine the application out of order does not mean that the information cannot be required later under 37 CFR 1.105 because it is reasonably necessary for the examination of the application. The Examiner would also note that the type of information required to support a petition to make special is specified by the MPEP. The Examiner's authority to request information reasonably necessary to properly examine the application is given in the rules. The clear language of the rules takes precedence over the language of the MPEP.

The Applicants also argue that it is unfair to require the Applicants to identify the allegedly infringing method since responding to the requirement may provide the basis

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for the alleged infringer to bring a declaratory judgment action against the Applicants.

The Examiner would merely note that the Applicants *chose* to file the petition to make special based on infringement. The Applicants did not have to. The Applicants could have avoided this potential problem by not filing the petition to make special and merely waiting to have their application examined in turn. In the alternative, the Applicants could have filed a petition for accelerated examination MPEP 708.02(VIII). It is not unfair to have the Applicants live with the consequences of their choices.

The Applicants also argue that the identity of the alleged infringing method is privileged information that was never intended to be required under the rule. This argument is not deemed persuasive because the Applicants merely assert it without providing any proof that this assertion is true.

### ***Conclusion***

This requirement is being mailed as a second request for information as opposed to a notice of nonresponsive reply/amendment because it is introducing the additional requirement that the Applicants provide the copy of the rigid comparison as well as to identify the alleged infringing method.

This requirement is subject to the provisions of 37 CFR 1.134, 1.135, and 1.136 and has a shortened statutory period for response of **TWO (2) MONTHS**.  
EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Caldwell, whose telephone number is (703) 306-3036. The examiner can normally be reached on M-F from 9:00 a.m. to 5:30 p.m. EST.

Fax numbers for Group 2100 are as follows:

Fax Responses: (703) 872-9306

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-9600.



Andrew Caldwell  
Supervisory Primary Examiner  
703-306-3036  
July 9, 2004

(AC)

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